

# **EXHIBIT 5**

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IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

MEDRAD, INC. )  
Plaintiff, )  
v. ) Civil Action No. 01-1997  
TYCO HEALTHCARE GROUP LP, )  
et al., )  
Defendants. )

MEMORANDUM

Gary L. Lancaster,  
District Judge.

October 26, 2005

Before the court is plaintiff's motion to alter judgment under Federal Rule of Civil Procedure 59(e) [doc. no. 297]. Plaintiff contends that such relief is appropriate because this court's October 12, 2005 Memorandum and Order, which invalidated plaintiff's patent on the grounds of defective reissue, is based on a misunderstanding of its position and makes new law. First, plaintiff asserts that the court erred by failing to understand that plaintiff was actually arguing that its reissue application was filed to correct a statutorily identified correctable error. As to the second alleged error, plaintiff argues that this court's decision makes new law by requiring that a reissued patent change the wording of the claims.

Because we do not find that our opinion suffers from either of these alleged errors, plaintiff's motion is denied. Although we can appreciate that plaintiff is disappointed by and disagrees

with our decision, these are not appropriate reasons for altering the judgment.

1. Error #1: Plaintiff's Argument

Plaintiff contends that its argument has always been, or was always been intended to be, that its reissue application was filed in order to fix an underclaiming error. Plaintiff identifies several pages from the transcript of oral argument on the cross motions for summary judgment where it mentions underclaiming errors to support its contention. We will resist the temptation to parse out each of plaintiff's statements, and reveal its context and meaning. Suffice it to say that at oral argument, upon sensing the court's discomfort with reading the correctable defects language out of the statute, plaintiff attempted to fit its situation within the parameters of one of the four statutory defects, i.e., an underclaiming error. However, regardless of the labels or catch phrases recited at oral argument, plaintiff's real argument was, and always had been, that section 251 could be used to fix procedural prosecution mistakes resulting in the invalidity of a patent. The court understood plaintiff's argument.

Moreover, even were we to frame plaintiff's argument in the way it now advances, our decision would not change. According to

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plaintiff, it made an underclaiming error because its procedural prosecution mistake caused the ITC to invalidate its patent. Under that reasoning, any error that results in a partly or wholly invalid patent would, by definition, be an underclaiming error. The language and structure of the statute, and the case law applying it, does not support a reading of the reissue statute that allows any and all errors to be remedied under the guise of an alleged "underclaiming error." As set forth in our original opinion, the reissue statute has its limits. See Opinion at p. 11.

## 2. Error #2: New Law

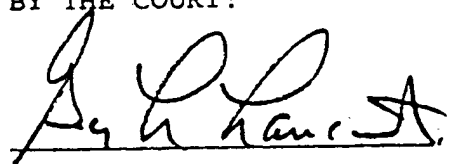
Next, plaintiff alleges that this court's opinion was erroneous, and created new law, in requiring that the wording of the claims change as a result of the reissue process. Plaintiff cites to numerous decisions in which the language of the claims was not changed as a result of the reissue process in an attempt to prove its point. However, all of the cases cited by plaintiff deal with faulty priority and inventorship claims. We explicitly acknowledged in our original opinion that some courts interpret underclaiming errors to include errors in priority claims and inventorship claims. See Opinion at pp. 18-19.

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In addition, these cases do not hold, as plaintiff contends, that "section 251 permits reissue to correct claiming errors not involving changes in the wording of the patent claims." Motion at p. 12. To the extent any of the cases are controlling, they stand for no more than the previously acknowledged fact that some courts consider errors in claiming priority and inventorship to be "claiming errors" under section 251. We were aware of and reviewed the relevant case law in our original opinion, and explained our reasoning in reaching our decision. That plaintiff disagrees with us does not mean that we have created new law, or necessarily misinterpreted or misapplied existing law.

Therefore, there being no grounds to alter the judgment, this 26<sup>th</sup> day of October, 2005, IT IS HEREBY ORDERED that plaintiff's motion to alter judgment [doc. no. 297] is DENIED.

BY THE COURT:

 J.

cc: All Counsel of Record